

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application of

Oliver STANCHFIELD

Serial No.: 10/748,852

Filed: December 31, 2003

For: **REVERSIBLE DECORATIVE MOLDINGS BETWEEN FLOOR AND WALL OR
WALL CEILING**

APPEAL BRIEF

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(i) REAL PARTY IN INTEREST

The real party in interest is the assignee of the inventor's interest, Pergo (Europe) AB, a company formed under the laws of Sweden having a principal address in Trelleborg, Sweden.

(ii) RELATED APPEALS AND INTERFERENCES

There is no known prior or pending appeals, judicial proceedings or interferences, known to Appellant, his assignee, or undersigned counsel which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

(iii) STATUS OF CLAIMS

Claims 2-5, 7, 8, 10, 12-16 and 20-33 stand finally rejected and are the subject matter of this appeal. Claims 1, 6, 9, 11, 17-19, all the other claims in this application have been cancelled.

(iv) STATUS OF AMENDMENTS

There has been no Amendment after Final Rejection filed in this application.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

This application contains three (3) independent claims, i.e. claims 4, 14 and 20.

(A.) CLAIM 4

Claim 4 is directed to a wood based reversible molding comprising a wood based core (20) (Specification page 5, lines 12-13) said core being shaped as a wall base molding (10) (Specification page 4, lines 10-18) a shoe molding (30) (Specification page 5, lines 1-6), or a quarter round molding (Specification page 4 lines 19-21); the shaped core having a plurality of decorative faces (11,12) affixed to the shaped core (20) (Fig. 1) wherein at least two of the faces differ in at least one property selected from the group consisting of texture, design, pattern and color (Specification page 1, lines 3-5); wherein said faces (11,12) (Fig.1) have the same shape, and each of the decorative faces is independently selected from the group consisting of foil laminate, veneer, paint, stain, and clear protective material (Specification page 6, lines 1-3), with

the proviso that the orientation of the core against a wall will expose at least one, but not two, of the faces (11,12), wherein at least one decorative face comprises a printed décor paper and an overlay of α -cellulose.

(B.) CLAIM 14

Claim 14 is directed to a wood based reversible wall base, shoe or quarter round molding comprising a wood based core (40) (Specification page 5, lines 12-13) having a plurality of faces (41, 42) affixed to the core (40) wherein at least two of the faces (41, 42) differ in shape (Fig. 4) (Specification page 6, lines 17-19) and at least one property selected from the group consisting of texture, design, pattern, and color (Specification page 6, lines 18-19) and each of the faces independently comprise at least one selected from the group consisting of foil, paint, clear protective material, stain, laminate and veneer (Specification page 6, lines 1-5) with the proviso that the orientation of the core (40) against a wall will expose at least one, but not two, of said faces (41, 42).

(C.) CLAIM 20

Claim 20 is directed to a method of reducing molding inventories (Specification page 2, lines 1-4 and 11-12).

The method includes offering a wall base, shoe, or quarter round molding to a purchaser of wall base, shoe or quarter round molding inventories, said wall base (10), shoe (30) or quarter round molding comprising a plurality of decorative faces (11, 12) affixed to a wood-based core (20) of the wall base (10), shoe (30) or quarter round molding such that rotation of the wood-based core (20) will expose at least one of the decorative faces (11, 12) wherein at least two said faces differ in at least one property selected from the group consisting of texture, design, pattern, color and shape (Specification page 1, lines 3-5) and each of the faces independently comprise at least one selected from the group consisting of foil, laminate, veneer and clear protective material (Specification page 6, lines 1-3) and selling said wall base (10), shoe (30) or quarter round molding to a purchaser.

(vi) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejection of claims 2, 4, 5, 7, 10, 12, 13, 25 and 31 under 35 U.S.C. 103 (a) as unpatentable over Pamplin (U.S. Publication 2004/0060251) in view of Kornfalt et al. (U.S. Patent 6, 517, 935).
2. The rejection of claim 3 under 35 U.S.C. 103 (a) as being unpatentable over Pamplin in view of Kornfalt, as applied to claim 4 above, and further in view of Lamont et al. (U.S. Patent 5, 711, 123).
3. The rejection of claims 4, 8 and 30 under 35 U.S.C. 103 (a) as being unpatentable over Sumner (GB 2,141,457 A) in view of Pamplin and Kornfalt.
4. The rejection of claims 20, 27 and 33 under 35 U.S.C. 103 (a) as being unpatentable over Pamplin.
5. The rejection of claims 14-16, 20-24, 26, 28, 29* and 32 under 35 U.S.C. 103 (a) as being unpatentable over Ford (GB 2,096,665A) in view of Pamplin.

*Claim 29 is not identified in the statement of the rejection, but the Examiner includes reference to Ford *vis-à-vis* claim 29 in the body of the rejection.

(vii) ARGUMENT

(1.) THE REJECTION OF CLAIMS 2, 4, 7, 10, 12, 13, 25 AND 31 UNDER 35 U.S.C. 103 (a) AS BEING UNPATENTABLE OVER PAMPLIN IN VIEW OF KORNFALT.

Although the Examiner alleges that Pamplin discloses a wood-based reversible molding (26) comprising a core (Fig. 3) said core being shaped as a wall base molding, said shaped core having a plurality of decorative faces (34) affixed to the core (Specification page 3, paragraph 32), Pamplin does not in fact contain such a teaching.

Pamplin teaches a decorative border assembly, including one or more molding strips. However, the decorative border assembly is not a reversible molding. As shown in Pamplin (Figs. 1-3) Pamplin teaches a decorative border assembly which “may be mounted adjacent a

ceiling as shown, or mounted elsewhere on a wall, for instance, as a chair rail” (paragraph [0027]). The decorative border assembly 10 includes a plurality of a elongated molding strips 12 which includes “spaced apart upper and lower retaining channels 18, 20” (paragraph [0028]). These molding strips are neither reversible, nor do they contain a plurality of faces with differing decorative surfaces.

As disclosed by Pamplin, “these molding strips when mounted adjacent a ceiling, may serve as crown molding, and may suitably have a curved appearance like that of channeled crown molding of Esdom”. Alternatively, as shown in Figs. 2 and 7, “the surface between the retaining channels may be generally planar” (paragraph [0028]). Pamplin continues in paragraph [0031] “with reference to Figs. 2-7, a decorative border assembly in accordance with the invention further typically includes one or more elongated mounting (not “molding”) strips 26 of a suitable material, for instance, plastic, with a semirigid material being advantageous”. Pamplin continues (paragraph [0032]) “with reference to Fig. 3 in particular, a length of patterned wall paper 27 or fabric is typically applied to a face 28 of mounting strip 26 to produce a patterned strip 34, which terminates in an end 35. Conventional wallpaper adhesives or the like may be used to fix the wallpaper or fabric to the mounting strip. As a result, numerous commercially available wallpaper patterns or fabrics may advantageously be selected from. However, if desired, the mounting strip may be provided with a suitable decorative pattern directly printed thereon”.

Therefore, contrary to the Examiner’s characterization of Pamplin, Pamplin does not disclose a wood-base reversible molding as alleged in paragraph (2.)(a) of the Final Rejection. Pamplin does teach that a molding strip may have spaced apart upper and lower retaining channels 18, 20 in order to receive elongated plastic mounting strips 26 with the mounting strips exhibiting various decoration, such as wall paper 27 or a fabric applied to a face 28 of mounting strip 26 to produce a pattern strip 34 as shown in Figs. 1-3 of Pamplin. There is absolutely no disclosure of a wood-based reversible molding comprising a core shaped as a wall base molding as alleged in the Office Action. The alleged “faces” to which the Examiner refers, is not to a

wood-based molding, but rather to a plastic mounting strip 26 and which may be covered with wall paper or fabric. There is no disclosure that any wood-based core having a plurality of decorative faces affixed to the core, as in independent claim 4, nor any indication that the core can be oriented against a wall to expose at least one, but not two of the faces, as in the claimed invention. All that Pamplin shows is a plastic insert 26, on opposite sides of which may be adhered a wall paper 27 or fabric, as shown in Fig. 3. Claim 4 includes a further limitation, that at least one of the decorative faces comprises a printed décor paper and an overlay of α -cellulose which clearly Pamplin also does not teach. The Examiner cites Kornfalt as teaching a molding with décor paper having an overlay of α -cellulose and the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Pamplin to include an overlay of α -cellulose such as taught by Kornfalt in ordinary to better protect the molding.

The fallacy in this purposed combination of rejections is that neither Pamplin nor Kornfalt teaches any reversible wood-based molding comprising a wood-based core with a plurality of decorative faces, which decorative faces need to be protected.

As noted above, Pamplin only teaches a plastic insert 26 upon which wall paper 27 or fabric may be applied and such plastic 26 is held in channels 22 of a molding. The molding itself however, is not reversible, there is no wood-based core having a plurality of decorative faces and therefore even if Pamplin was modified to substitute the décor paper with an overlay of α -cellulose as in Kornfalt, for either the wall paper or fabric of Pamplin, the result for such combination would still not be the claimed invention. Additionally, neither Pamplin nor Kornfalt teach wall base moldings (nor shoe moldings nor quarter round moldings) as recited in independent claim 4.

Although the Examiner, in connection with dependent claim 7, alleges that one of the faces is in the shape of a wall base molding (citing paragraph [0027] of Pamplin), Pamplin does not teach wall base molding but only crown molding or chair rail (See paragraphs [0027]-[0028]).

Rejections based on 35 USC 103 (a) must rest on a factual basis.

In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

The United States Supreme Court instructs that:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007).

Here, the examiner provides no reason for making the proposed combination, nor even fulfills her obligation as a fact finder, to find **all** the recited elements of the claims. Rather, like the examiner in *Warner*, *supra*, the examiner resorts to unfounded speculation, even resorting to paraphrasing the claim language and attributing that to a teaching in the prior art, where no such teaching is referenced in the prior art, in a failed attempt to satisfy the burden placed upon the examiner as a fact finder.

Thus, it is clear that independent claim 4 (and by statute-35 U.S.C. 112, fourth paragraph all the claims dependent thereon) are not obvious in the sense of 35 U.S.C. 103 (a) over the proposed combination of Pamplin in view of Kornfalt.

(2.) THE REJECTION OF CLAIM 3 AS UNPATENTABLE OVER PAMPLIN IN VIEW OF KORNFALT AS APPLIED TO CLAIM 4 AND FURTHER IN VIEW OF LAMONT UNDER 35 U.S.C. 103 (a)

This rejection also fails to establish a prima facie case of obviousness for the claimed invention.

Although the Examiner alleges that “Pamplin in view of Kornfalt et al. disclose the invention as claimed except for each decorative face comprising a curved surface”, claim 3 also includes all the limitations of independent claim 4 upon which it depends. As noted above, the proposed combination of Pamplin in view Kornfalt does not contain all the limitations of independent claim 4 and thus cannot possible establish a prima facie case in view of Lamont which allegedly is cited only to show “a molding (4) having a plurality of decorative faces each having the same shape (Fig. 3; column 4, lines 1-30), wherein orientation of the molding against the wall will expose at least one but not two of said faces and each of the decorative faces can comprise a curve surface (Fig.3).

Like, Pamplin, Lamont fails to teach a wood-based core upon which are mounted a plurality of decorative faces. Lamont, like pamplin discoses a molding which acts as a holder for a decorative panel, which may be formed of plastic or stiffened cloth (Column 2, lines 34-36 and 45-47. The Examiner does not allege that Lamont cures the above noted defects in Pamplin in view of Kornfalt (applied to independent claim 4 for the reasons as noted by appellant above) and thus claim 3 still fails to establish a prima facie case of obviousness because the Examiner has not acted as a fact finder to find each of the factual bases for the recited limitation of the claims. The Examiner merely makes conclusory statements concerning the prior art, sometimes even paraphrasing applicant’s claim language, but fails to show where, in the art relied upon in the rejection, such features are found. For the foregoing reasons, applicant respectfully submits that claim 3 is not properly rejectable under 35 U.S.C. 103 (a) because the Examiner has not found each of the recited elements of the claims in the proposed combination of references.

(3.) THE REJECTION OF CLAIMS 4, 8 AND 30 UNDER 35 U.S.C. 103 (a) AS BEING UNPATENTABLE OVER SUMNER IN VIEW OF PAMPLIN AND KORNFALT.

Again although the Examiner alleges that “Sumner discloses a reversible molding (12) having a plurality of decorative faces (left side, right side) wherein the faces have the same shape (Fig.1) and the molding can be oriented against the wall to expose at least one but not two of said faces” Sumner contains no such teachings.

While the Examiner clearly recognizes deficiencies in Sumner such that the Examiner concedes that “Sumner does not specifically disclose that the molding is a wood-based molding with a wood-based core, and the plurality of decorative faces are affixed to a core and differ by texture, design, pattern or color and independently comprise foil, laminate, veneer, paint, stain or clear protective material and wherein at least one of the decorative faces comprise a printed décor paper with an overlay of α -cellulose,” Sumner in fact does not even teach that element 12 is a reversible molding. The Examiner again merely make conclusory statements that strip 12 of Sumner is a reversible molding but the reference itself does not contain such a disclosure. As noted above, Pamplin is also deficient in disclosing a reversible molding because element (26) to which the Examiner refers to in Pamplin is not a wood-based core but a plastic strip. Even with a modification of the decorative face of plastic strip (26) to include décor paper with an overlay of α -cellulose as in Kornfalt, such still does not convert the proposed combination into a reversible wood-based molding as claimed. For all the foregoing reasons, applicant respectfully submits that the proposed combination of references still does not establish a *prima facie* case of obviousness for the claimed invention because the Examiner has still missed the core limitations of the claimed invention by failing to cite any reversible wood-based molding comprising a wood-base core having a plurality of decorative faces, such that the faces can be alternatively oriented against a wall to expose one, but not both, of the decorative surfaces.

(4) THE REJECTION OF CLAIMS 20, 27 AND 33 UNDER 35 U.S.C. 103 (a) AS BEING UNPATENTABLE OVER PAMPLIN

Although, again, the Examiner merely alleges that “Pamplin discloses a method of “inherently” reducing molding inventories comprising offering a wall base molding comprising a plurality of decorative faces (34) affixed to the wood-based core (paragraph 27) of the molding such that rotation of the core (flipping it over) will expose at least one of the decorative faces...” such is nowhere disclosed by Pamplin. Pamplin does not teach wall base molding. Pamplin does not teach a wood-based core having a plurality of decorative faces. Pamplin does not teach rotation of a wood-based core (flipping it over) will expose at least one of the decorative faces, nor does Pamplin teaches that one of the faces is one selected from the group consisting of foil, laminate, veneer and clear protective material and thus Pamplin is clearly deficient as a teaching reference in order to establish a prima facie for claims 20, 27 and 33.

(5) THE REJECTION OF CLAIMS 14-16, 20-24, 26, 28 AND 32 UNDER 35 U.S.C. 103 (a) AS BEING UNPATENTABLE OVER FORD IN VIEW OF PAMPLIN

The proposed combination of Ford and Pamplin still fails in the basic concept of teaching reversible wood-based molding formed from a wood-based core having a plurality of decorative faces thereon. As noted above, Pamplin clearly does not teach a wood-based core having a plurality of decorative molding faces. The combination of Pamplin and Ford still does not correct that deficiency. Ford teaches a cove tile such as shown in Figs. 2 and 4, where the cove tile can be reversed to present a different shape so as to join in a different matter with a floor F. However, the Ford tile is of the type known as “ceramic” tiles as noted at page 2, lines 56-64 in which the tiles are adhered with adhesive or cement. There is no disclosure whatsoever, of a wood-based core in Ford, nor of decorative faces affixed to the wood-based core, nor the faces selected from the group as specified in either independent claim 14 or 20. Pamplin’s plastic strip 26 is also not a wood-based core, nor is in fact a molding whatsoever, but a mere insert into channels so as to exhibit either the wall paper or the fabric side of the plastic strip. Therefore,

the proposed combination of Ford and Pamplin still does not establish a prima facie case of obviousness under 35 U.S.C. 103 (a) because the basic concept of the invention as specified in independent claim 20 i.e., a method of reducing molding inventory for wood-based moldings is clearly not conveyed to the ordinary worker skilled in the art by the proposed combination of Ford and Pamplin. Furthermore, the invention as specified in independent claim 14 of providing a wood-based molding comprising a wood-based core 14 having a different decorative faces where the decorative faces not only differ in shape, but also in the material which forms the decorative faces, is not suggested by the proposed combination of the Ford and Pamplin teachings.

(viii) CONCLUSION

For the foregoing reasons, reversal of all rejections by the Board is respectfully requested.

(ix) CLAIMS APPENDIX

A copy of the claims on Appeal can be found in the claims Appendix

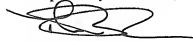
(x) EVIDENCE APPENDIX

Not applicable

(xi) RELATED PROCEEDING APPENDIX

Not applicable

Respectfully submitted,



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Date: December 28, 2009
Atty Docket No. 8688.024.US00000

APPENDICES

The following Appendices are attached to and made a part of this brief:

| | |
|------------|---------------------------|
| Appendix A | Claims on Appeal |
| Appendix B | Evidence (N/A) |
| Appendix C | Related Proceedings (N/A) |

APPENDIX A: Claims on Appeal

2. The reversible molding of claim 4, wherein the molding comprises a wood product selected from the group consisting of particle board, MDF, HDF and veneered lumber.

3. The reversible molding of claim 4, wherein the decorative faces comprise a curved surface.

4. A wood-based reversible molding comprising a wood-based core, said core being shaped as a wall base molding, a shoe molding, or a quarter round molding; said shaped core having a plurality of decorative faces affixed to said shaped core wherein at least two of said faces differ in at least one property selected from the group consisting of texture, design, pattern, and color, wherein said faces have the same shape and each of said decorative faces is independently selected from the group consisting of foil, laminate, veneer, paint, stain, and clear protective material, with the proviso that the orientation of the core against a wall will expose at least one, but not two, of said faces, wherein at least one decorative face comprises a printed decor paper and an overlay of α -cellulose.

5. The wood-based reversible molding of claim 4, wherein at least one decorative face comprises laminate.

7. The wood-based reversible molding of claim 4, wherein each of said faces is in the shape of a wall base molding.

8. The wood-based reversible molding of claim 4, wherein each of said faces is in the form of base shoe.

10. The combination of a floor and wall joint with the wood-based reversible molding of claim 4.

12. The combination of a laminate floor and wall joint with the wood-based reversible molding of claim 4.

13. The combination of at least one laminate wall panel in combination with the wood-based reversible molding of claim 4.

14. A wood-based reversible wall base, shoe, or quarter round molding comprising a wood-based core having a plurality of decorative faces affixed to said core wherein at least two of said faces differ in shape and at least one property selected from the group consisting of texture, design, pattern, and color, and each of said faces independently comprise at least one selected from the group consisting of foil, paint, clear protective material, stain, laminate, and veneer, with the proviso that the orientation of the core against a wall will expose at least one, but not two, of said faces.

15. The wood-based reversible molding of claim 14, wherein the reversible molding comprises a core comprising one selected from the group consisting of particle board, MDF and HDF upon which the decorative faces are affixed.

16. The wood-based reversible wall base, shoe or quarter round molding of claim 14, wherein at least one of said faces comprises a foil.

20. A method of reducing molding inventories comprising:
offering a wall base, shoe or quarter round molding to a purchaser of wall base, shoe or quarter round molding inventories, said wall base, shoe or quarter round molding comprising a plurality of decorative faces affixed to a wood-based core of the

wall base, shoe or quarter round molding such that rotation of the wood-based core will expose at least one of the decorative faces wherein at least two of said faces differ in at least one property selected from the group consisting of texture, design, pattern, color and shape, and each of said faces independently comprise at least one selected from the group consisting of foil, laminate, veneer and clear protective material; and
selling said wall base, shoe or quarter round molding to said purchaser.

21. The wood-based reversible molding of claim 14, wherein each of said faces comprises a foil.

22. The wood-based reversible molding of claim 14, wherein at least one of said faces is in the shape of a wall base molding.

23. The reversible molding of claim 24, wherein at least a second one of said faces is in the form of at least one molding selected from the group consisting of a quarter round and base shoe.

24. The reversible molding of claim 14, wherein at least one of said faces is in the form of at least one molding selected from the group consisting of a quarter round and base shoe.

25. The wood-based reversible molding of claim 4, wherein the wood-based core comprises a material selected from the group consisting of natural wood and veneered lumber.

26. The wood-based reversible molding of claim 14, wherein the core comprises a material selected from the group consisting of natural wood and veneered lumber.

27. The method of claim 20, wherein the core comprises a material selected from the group consisting of natural wood and veneered lumber.

28. The wood-based reversible molding of claim 14, wherein at least one of the decorative faces comprises a curved surface.

29. The method of claim 20, wherein at least one of the plurality of decorative surfaces comprises a curved surface.

30. The wood-based reversible molding of claim 4, wherein each of said faces is in the form of a quarter round.

31. The wood-based reversible molding of claim 4, wherein each of said faces differs from each other of said faces.

32. The wood-based reversible molding of claim 14, wherein each of said faces differs from each other of said faces.

33. The method of claim 20, wherein each of said faces differs from each other of said faces.

APPENDIX B: Evidence Appendix under 37 CFR §41.37(c)(1)(ix)

N/A

APPENDIX C: Related Proceedings Appendix under 37 CFR §41.37(c)(1)(x)

N/A